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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/704,425	11/01/2000	Kevin J. Nicholls	WA23-040	4626

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EXAMINER

COSIMANO, EDWARD R

ART UNIT PAPER NUMBER

3629

DATE MAILED: 04/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/704,425

Applicant(s)

NICHOLLS ET AL.

Examiner

Edward R. Cosimano

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☒ Claim(s) 14-35 is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☒ Claim(s) 3-13 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11/1/00 & 6/30/04 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

1. The proposed drawing correction and substitute sheets filed June 30, 2004 have been approved.

2. The use of various trademark(s), for example: "Zip™";

A) in the paragraph between page 8, line 4, and page 9, line 11, "With reference to the various systems ... Zip™ drive ... computer system making up the host computer."

has been noted in this application. Any trademarks should be capitalized wherever they appear and be accompanied by the generic terminology.

2.1 Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

3. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings. Applicant should note the requirements of 37 CFR § 1.74, § 1.75, § 1.84(o,p(5)), § 1.121(a)-1.121(f) & § 1.121(h)-1.121(i).

4. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

(c) Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

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4.1 Claims 1 & 2 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the Arkansas Business article, herein after (AB) or Callen (6,556,976) in view of obvious practical concerns.

4.1.1 In regard to claims 1 & 2, either AB or Callen ('976) discloses a first party that access:

A) and stores historical consumption/billing information for the various goods/services that are consumed/used by the user as obtained from the providers of the good/service; and

B) a database of costing/pricing/rating information for the goods/services from various providers of the good/services that are supplied to the user.

The first party then processes the stored historical consumption/billing information for the user by analyzing the historical consumption information in view of the rating information that is stored in the data base in order to determine the optimum/best provider of the goods/services that are consumed by the user. Once the optimum provider of the goods/services consumed by the user has been determined by the first party, then the user is notified of the identified optimum provider of the goods/services consumed by the user. From this information the user may act appropriately in order to benefit from the results of the first party's analysis.

4.1.2 In regard to the remote computerized viewing of the results of the analysis by the user, it is noted that with out the user/customer being able to review and then act upon the results of the first party's analysis, regardless of how the results may be provided to the user, then the user would not know what the results of the first party's analysis are and therefore could not benefit from the potential cost savings that may be provided to the user from the optimum provider have been indicated by the first party's analysis, therefore, it would have been obvious to one of ordinary skill a the time the invention was made that the systems of either AB or Callen ('976) could be modified to provide to the user/customer the ability to view and act upon the results of the first party's analysis by the use any suitable method of communicating the results to the user, such as a computer viewable data, so that the results of the first party's analysis may accomplish a practical application.

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5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR § 1.136(a).

4.1 A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR § 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

6. The following is an Examiner's Statement of Reasons for Allowance over the prior art of record:

A) in regard to claims 3 & 23, the prior art does not teach or suggest processing historical billing data for a customer in order to determine tolerance parameters for the consumption information of the customer and then using an audit of the customer's consumption data to determine if the consumption data meets the determined tolerances. Claims 4-13 are allowable over the prior art for the same reason.

B) in regard to claim 9, the prior art does not teach or suggest processing only utility rate information that meets the cost saving tolerance parameter for the consumption history information of the customer. Claims 10-13 are allowable over the prior art for the same reason.

C) in regard to claim 10, the prior art does not teach or suggest permitting the user to act on the processed information/data and then using any determined cost savings by the customer as a shared fee among the first and second parties. Claims 11-13 are allowable over the prior art for the same reason.

D) in regard to claim 14, the prior art does not teach or suggest subscribing a customer to a rate schedule that provides cost savings based on the results of processing historical consumption history data against predetermined tolerance values and rate

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schedules then compensating the parties based on the cost savings of the user/customer. Claims 15-20 are allowable for the same reason.

E) in regard to claims 21, 27 & 33, the prior art does not teach or suggest processing historical consumption history data that meets predetermined tolerance values with rate data schedules to identify potential cost savings and then using the results of the processing to permit the user/customer to select a rate schedule that would provide cost saving to the user/customer, while compensating the parties based on the cost savings of the user/customer. Claims 22-26, 28-32, 34 & 35 are allowable for the same reason.

7. Response to applicant's arguments.

7.1 All rejections and objections of the previous Office action not repeated or modified and repeated here in have been over come by applicant's last response.

7.2 As per the objection to the disclosure, since applicant failed to address or correct this problem, this objection has been repeated.

7.3 As per the 35 U.S.C. § 103 rejection, since, with out the user actually implementing the determined rate that would produce cost savings, the systems/methods of either the Arkansas Business article or Callen (6,556,976) would have no practical value, applicant's arguments are non persuasive.

8. Claims 3-13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (703) 305-9783 (after 13 April 2005 (571) 272-6802). The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss, can be reached on (703)-308-2702 (after 13 April 2005 (571) 272-6812). Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

9.1 The fax phone number for UNOFFICIAL/DRAFT FAXES is (703) 746-7240.

9.2 The fax phone number for OFFICIAL FAXES is (703) 872-9306.

9.3 The fax phone number for AFTER FINAL FAXES is (703) 872-9306.

03/23/05



Edward R. Cosimano
Primary Examiner A.U. 3639